

allowed, over the same prior art applied by Primary Examiner Pryor against the present applicants (i.e., Goodenough U.S. 3,558,503). During the '229 prosecution, the bases argued for patentability of current claim 10 of the '229 patent were accepted as convincing by the PTO and they are equally applicable to the instant claims.

Fairness and common sense dictate that the present claims be found allowable so that an interference can be declared. Priority and patentability as to the instant application and the '229 patent can then be resolved on an inter partes basis (i.e., in a proceeding which involves applicants, Nalco and the Commissioner).

Moreover, as also explained at the interview, there are differences between the Goodenough disclosure and applicants' claims which are summarized below. These differences demonstrate that the claimed process is novel, and the only issue is obviousness where motivation from the prior art to make the changes needed to reconstruct the claims (and not from hindsight) and reasonable expectation of success are critical considerations.

Differences In Process Steps -- Goodenough states at Col. 2, lines 10-12 that "the order of addition" of his reagents "is not critical to the operability of the invention." Nonetheless, Goodenough states that stabilization "is optimized if the hydroxide is added last" (Col. 2, lines 12-15). By contrast, the arguments Nalco presented during the '229 prosecution in response to a similar rejection over Goodenough pointed out that the order of addition of ingredients was important to the process instantly claimed (see pages 3-4 of Response filed by Nalco on December 13, 1999; copy submitted with prior amendment). Applicants' process as defined in claims 61-65 recites the same sequence of steps as in the '229 claims, and therefore differs in that same manner over Goodenough. The claimed sequence adds bromine last (Goodenough adds hydroxide last in the preferred embodiment) thereby allowing the bromine to contact the mixture of hydroxide, water and sulfamic acid.

In response to this argument by Nalco, the '229 patent claims at issue were deemed allowable, the Examiner stating in the Notice of Allowability, page 3, that there was no "motivation for one of ordinary skill in the art" to make the necessary changes to arrive at Nalco's claims. The same conclusion applies here, because applicants' claimed process sequence is the same as Nalco's, that sequence is not described in Goodenough and Goodenough's preferred sequence is distinctly different.

Differences in pH -- Goodenough's process is conducted at "controlled pH levels" (Col. 1, line 17). This "controlled" pH is stated to be in the range of about 8 to about 10 (Col. 1, lines 71-72). The preferred Goodenough pH range is about 9.0 to about 9.6 (Col. 2, lines 58-60). By contrast, applicants' claimed pH range starts at about 12, a considerably higher pH than the highest "controlled pH level" of Goodenough, and even higher as compared to Goodenough's preferred range (up to 9.6 -vs- 12).

Selection of Hydroxide -- Goodenough's process may use either alkali or alkaline earth metal hydroxides (Col. 2, lines 35-40). Applicants' claims specify alkali metal hydroxide. Goodenough's preferred hydroxide is magnesium hydroxide, an alkaline earth metal hydroxide (see Col. 3, lines 1-3 and Col. 2, lines 60-61). Goodenough does not suggest any advantage to selecting alkali metal hydroxide, and prefers other hydroxides.

Differences in Results -- Goodenough's process produces bromine values from 0.01 to about 100,000 ppm (Col. 1, lines 38-42). The reference prefers considerably lower values, namely up to only about 50,000 ppm (see Col. 2, lines 55-58). Applicants' different process produces products with an active bromine content of at least about 100,000 ppm, and can go considerably higher (see applicants' specification, page 5, lines 16-25). Nothing in Goodenough suggests that such high values (as much as two times higher than Goodenough's preferred range) could be achieved by modifying the processes taught in the Goodenough patent.